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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
| 08/825, 565 | 03/31/97 | OYAMA | S 1095.1071/JD |

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EXAMINER

WEINHARDT, R

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| ART UNIT | PAPER NUMBER |
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2764

DATE MAILED:

06/28/99

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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|------------------------------|--------------------------------------|-------------------------------------|
| Office Action Summary | Application No. 08/825,565 | Applicant(s) Oyama et al. |
| | Examiner Robert Weinhardt | Group Art Unit 2764 |

Responsive to communication(s) filed on _____.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-14 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-14 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2764

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 9-10 are rejected under 35 U.S.C. 112, first paragraph, because the specification does not reasonably provide enablement for a claim covering every conceivable means for achieving the recited purpose. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims.

Claim 9 is a single means claim and thus has undue breadth as it covers every conceivable means for achieving the stated purpose. See MPEP 2164.08(a).

Claim 10 is rejected as it depends on claim 9 and only serves to further define that single means.

Art Unit: 2764

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-8, 10-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is not clear in that it recites a customer processing means "disposed at" the terminal station the supplies the first bank system with information. While "disposed at" indicates the location of the processing means, only the terminal station has been explicitly recited as being connected to the first bank system and thus it is not clear how the customer processing means can provide the first bank system the recited information. Similarly, the first and second bank processing means "disposed at" the first and second bank systems are not clear.

Claim 8 is also unclear in that it similarly recites means "disposed at" the terminal station that is not clearly connected to the network.

Claim 10 is not clear in that it recites the manner in which the data items are obtained by but does not clearly indicate what means are used to form the data items as recited. Does the processor means perform the recited encrypting?

In claims 11-14, the preambles call for allowing the customer to use "cyberspace banking services", but it is not clear how this is provided by the body of the claims. The

Art Unit: 2764

end result of these methods is accepting or rejecting the account application. This does not guarantee "cyberspace banking services" even after account acceptance.

Dependent claims not specifically mentioned above are rejected because by their dependence they include the language of a rejected base claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-4, 8-9, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss et al. in view of Atkins.

Weiss et al. teach a computerized system for opening a new account including a bank account such as a savings and/or checking account wherein a customer processing means is provided for applying for a new bank account by supplying the first bank system with information concerning the customer's financial and/or investment

Art Unit: 2764

situation and information necessary to open the new account. Weiss further teaches first bank processing means for opening the new account based on a confirmation message and that the new account can be opened by an existing customer. See the abstract, fig. 1, col. 4 line 60 to col. 5 line 14, col 7 line 50 to col. 8 line 49, col. 9 line 4 to col. 10 line 22, col. 12 line 63 to col. 13 line 14, col. 14 lines 18-61, col. 15 lines 35-45, col. 16 lines 4-18, col. 19 lines 21-28, col. 20 lines 18-35 of Weiss.

While Weiss does not explicitly teach that the "customer's financial and/or investment situation" includes existing bank accounts at other banks, those of ordinary skill in the art would have recognized that in order to accurately portray a customer's financial and/or investment situation, accounts from other banks would have been input into the system of Weiss. Thus, Weiss is seen to impliedly teach that collection of existing account information including accounts at other banks.

Weiss does not explicitly teach that the first bank processing means requests a second bank processing means to make a confirmation of an existing bank account. However, Weiss does at least teach that the first bank processing means performs a credit check on the applicant including contacting a credit bureau through the use of a modem or other communication equipment. Further, Atkins specifically teaches that when opening an account in a computerized system, other banks and financial service institutions may communicate with the system in order to verify asset or liability holdings or to transfer asset or liability holdings. See the abstract, fig. 2 and col. 9

Art Unit: 2764

lines 31-35 of Atkins. Thus, it would have been obvious to those of ordinary skill in the art to modify the teachings of Weiss to include the contacting of other banks to verify and/or transfer asset or liability holdings of an applicant for an account for the obvious advantage of increased security when opening the new account.

With respect to the use of an open network, Weiss specifically teaches that the customers can access the bank processing means remotely via their PC's. As is well known in the art, and Official Notice is taken thereof, common means for connecting PC's to business services include open networks, e.g. the Internet. Thus, it would have been obvious to those of ordinary skill in the art to modify the teachings of Weiss to include an open network connection for the customers' PC's already taught by Weiss for the obvious advantage of employing a readily available, off-the-shelf means of connection. With respect to the use of an "inter-bank" network, as this broad term merely calls for interconnecting the various bank processing means, this is seen to be provided in Weiss as noted above with respect to the verification and/or transfer of an applicant's holdings.

Concerning the content of the existing account information, as the second bank needs to be identified and contacted for verification and possible transfer of a particular customer's holdings, the existing account information must include a bank identification code of the second bank, an account number of the existing bank account and a password.

Art Unit: 2764

8. Claims 5-7, 10, 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss et al. in view of Atkins as applied to claims 1-4, 8-9, 11 above, and further in view of Micali.

Weiss and Atkins fail to specifically teach the use of cryptography between the customer processing means and the first and second bank processing means. Micali however, teaches an anonymous information retrieval system wherein a customer encrypts a request with a plurality of keys corresponding to the parties that the message must pass through and what information each party can be provided with.

Micali further teaches that the customer sends the request to a first entity, that portion pertaining to the first entity in the request is decrypted by the first entity and is then forwarded to a second entity. The second entity decrypts another portion of the message and sends the request to the database for retrieval of the desired information. The returned information is encrypted similarly considering the parties the information is to pass through. See the entire document of Micali. Thus, it would have been obvious to those of ordinary skill in the art to modify the teachings of Weiss and Atkins to include the cryptographic technique taught by Micali for the obvious advantage of limiting the exposure of the customer's private data.

Conclusion

Art Unit: 2764

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Larche et al. teach a computerized system for applying for credit. Norris teaches real-time closed-loop loan processing. Rosen suggests opening bank accounts remotely after digital credentials are issued (col. 26 lines 33+). Longfield teaches opening an account based on electronically filed information. Wynn teaches opening a new account on a financial data card. D'Agostino teaches remote financial assistance. DeFrancesco et al. and Jones et al. teach automated processing of financial applications.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Weinhardt whose telephone number is (703) 305-9780. The examiner can normally be reached on Monday-Friday from 7:30 AM - 4:00 PM. The examiner can also be reached at the e-mail address: robert.weinhardt@uspto.gov

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768. Facsimile transmissions to this Group may be directed to (703) 308-1396.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.



ROBERT A. WEINHARDT
PRIMARY EXAMINER

June 18, 1999